

39. (currently amended). The device according to ~~one of Claims~~ claim 35 [[to 37]], characterized in that

the CT scanner can be regulated in such a way that, with the centered projection of the tolerance volume with the X-ray source (5) as the center of projection,

- the smallest diameter of the projection of the tolerance volume onto the detector and the smallest diameter of the image field of the CT scanner are essentially equal in size, or the largest diameter of the projection of the tolerance volume onto the detector and the largest diameter of the image field of the CT scanner are essentially equal in size, or
- the largest diameter of the projection of the tolerance volume onto the detector and the smallest diameter of the image field of the CT scanner are essentially equal in size.

## **REMARKS**

Claims 1 through 39 continue to be in the case.

1. The Office Action of December 1, 2004 states that the acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 08 July 2000. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

The undersigned filed on August 5, 2003 a submission with a German priority document (20) pages and of a European Application dated July 21, 2003. The submission was accompanied by a transmittal letter reciting the documents as a German priority document (20) pages and of a PCT Application dated July 21, 2003.

The undersigned received a return postcard stamped August 11, 2003 indicating that these documents were received by the United States Patent and Trademark Office.

Recognition of the fulfillment of applicants' obligations to complete their claim to priority is respectfully requested.

The Office Action refers to the Specification

2. The abstract of the disclosure is objected to because it is longer than 150 words and not formatted as a single paragraph. Correction is required. See MPEP § 608.01(b).

Applicants are submitting a revised Abstract of the Disclosure with this response.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The Office Action refers to Claim Objections

4. Claims 9-12, 17-24, 31-34, and 38-39 stand objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claims 9, 12, 17 to 21, 23, 31, 34, 38, and 39 are amended in the present submission to obviate the claim objection.

The Office Action refers to Claim Rejections - 35 USC § 112

6. Claims 14-16 and 35-37 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claims 14-16 and 35-37, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d),

The Office Action refers to Claim Rejections - 35 USC § 102.

9. Claims 1-5 and 8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Schlöndorff et al. US 5,186,174 A. Schlöndorff shows all of the features of the instant invention including CT imaging, the coordinate measuring, the target position, the three reference points,

and the tolerance volume or area (abstract, columns 7-9). While Schlöndorff creates the CT image before the position measurements are made, the limitations of the claims as written are met. The automatic tool following meets the tolerance volume limitation.

The rejection of claims 1 to 5 and 8 based on United States that in 5,186,174 is respectfully traversed.

#### Claim 1

i. The feature according to paragraph a) of claim 1 of the application, according to which the coordinates of the object of the investigation are determined in the MG-coordinate system, is not taught or suggested in the reference United States patent 5,186,174. The feature according to paragraph a) is in particular not anticipated or suggested in view of claim one of the United States patent 5,186,174, where the position of the reference points of the object is determined in two different reference systems.

ii. The feature according to paragraph d) of claim 1 of the present application, wherein the object of the investigation is positioned by employing of the set point position found according to step c) such that the set point position of the structure comes to be positioned within the volume captured by the computer tomograph, is also not taught or suggested by the reference United States Patent 5,186,174. The

basic concept to position the object with the aid of a preceding calculation of position of the set point position in a particularly advantageous way is not taught in the reference United States patent 5,186,174 and is also not suggested to a person of ordinary skill in the art. According to the process which is subject matter of the reference United States patent 5,186,174, the object is not at all brought into a previously calculated position, but instead the object is simply placed onto a support (compare the reference United States patent 5,186,174, claim 1 column 9 lines 63 and 64) without that any conditions are imposed, present, or required on this placement position.

iii. It is an essential advantage connected with the basic concept of claim 1 of the present application to position the object from the beginning that is even prior to beginning of the CT-investigation in such a starting position by way of preceding non-damaging measurements and calculations that the (based on the radiation load damaging) CT-scanning always captures from the beginning the desired area.

This decisive advantage of the present application cannot be reached with the method according to the reference United States patent 5,186,174. In contrast the reference United States patent 5,186,174 requires that the object is positioned from the beginning in such a starting position that the tomogram in fact encloses the

desired region. How the object was brought into this starting position or, respectively, how the starting position is at all found is not subject matter of the reference United States patent 5,186,174, on the contrary the reference United States patent 5,186,174 is concerned exclusively with such steps (as for example the operating engagement or surgical action) which follow a positioning of the object.

iv. Therefore it is believed that the reference United States patent 5,186,174 does not anticipate or render obvious claim one of the present application.

## Claim 2

i. The feature according to paragraph a) of claim 2 of the present application, according to which the coordinates of the object to be investigated are determined in the CT-coordinate system, is also not suggested in the reference United States patent 5,186,174. In particular, this feature of claim 2 of the present application is not anticipated or suggested by the requirements of claim 1 of the reference United States patent 5,186,174 to determine the position of three reference points on the object in two different reference systems.

ii. In addition it is pointed to the statement under claim 1, point ii., which is also valid relative to claim 2 of the present application.

Claims 3 to 5 and 8:

These claims are sub claims of claims 1 or, respectively, 2. The claims 1 and 2 are deemed to be novel and unobvious as a pointed out above. The following statements refer to additional features of claims 3 to 5 and 8.

Claim 3

The three reference points employed according to the method of the reference United States patent 5,186,174 exclusively serve to set up the transformation prescription between the first data set and the second data set. The selection of the three selected points according to claims 3 of the present application serves as a reference for the position of the set point position and not for the furnishing of a transformation prescription between two data sets. Therefore it is concluded that the reference United States patent,186,174 does not oppose patentability of claim 3 of the present application.

#### Claim 4

The possibility, to position the object of the investigation such that both the set point position as well as also the actual position of the structure are disposed in the volume captured by the computer tomograph, is nowhere suggested in the reference United States patent 5,186,174, which is not surprising in view of the fact that this possibility results only through the essential advantage of the present Invention referred to in claim 1 of the present application. It is believed that United States patent 5,186,174 does not anticipate or render obvious claim 4 of the present application.

#### Claim 5

This claim concerns a particularly advantageous application of the possibility explained above with respect to claim 4 and not part of the reference United States patent 5,186,174, to position the object of the investigation such that both the set point position as well as also the actual position of the structure is the disposed in the volume captured by the computer tomograph. It is believed that claim 5 patentably defines the present Invention relative to the reference United States patent 5,186,174.



## Claim 8

The considerations set forth above in connection with claims 3, 4 and 5 hold correspondingly for claim 8. Correspondingly, it is believed that claim 8 is patentable over the reference United States patent 5,186,174.

### Allowable Subject Matter

10. Claims 25-30 are allowed.

The indication of allowability of claims 25 to 30 is gratefully acknowledged.

11. Claims 6, 7, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants still believe that the claims on which claims 6, 7, and 13 depend will be found allowable. Therefore applicants defer at this moment the writing of claims 6, 7, and 13 in independent form.

12. Claims 14-16 and 35-37 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 14 and 35 have been amended to overcome the rejections under 35 U.S.C. 112, second paragraph.

The Office Action concludes:

14. The Prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schlöndorff et al. US 5,494,034 A and Ben-Haim et al. US 6,498,944 B 1 show Ct systems with coordinate measuring instrumentation.

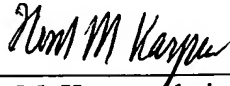
It is recognized that the cited prior art shows the technical state at the time of their publication, but the art neither anticipates nor renders obvious the present invention.

Reconsideration of all outstanding rejections is respectfully requested.

All claims as presently submitted are deemed to be in form for allowance and an early notice of allowance is earnestly solicited.

Respectfully submitted,

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